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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,441	04/14/2004	Kenichi Aihara	2271/60895-RE	8473

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EXAMINER

TRAN, THANG V

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/825,441

**Applicant(s)**

AIHARA ET AL.

**Examiner**

Thang V. Tran

**Art Unit**

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☒ Certified copies of the priority documents have been received in Application No. 09/471,345.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Reissue Applications***

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Applicant should note that the statement “The inadvertent failure to include at least one apparatus claim such as new claim 14 and/or one medium claim such as new claim 17 or new claim 19” is not an acceptable statement of an error.

2. Claims 1-20 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

***Claim Objections***

3. Claims 1-8, 14, 15, and 17-20 are objected to under 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1:

The term “receding”, line 9, should be --recording--.

The term -- of laser power-- should be inserted after “average”, lines 11 and 13; otherwise, it is unclear from the claim of what average the laser device has.

In claims 3, 4 and 6:

It is unclear and confusing from the claims as to whether or not the term “average” recited in claim 1 is that same as the term “average” as recited in these claims 3, 4 and 6.

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The term “an average”, in claim 3, lines 5 and 6-7, should be changed to --the average-- or --said average-- if the change in claim 1 would be made.

In claim 14:

The term -- of laser power-- should be inserted after “average”, lines 8 and 10; otherwise, it is unclear from the claim of what average the laser device has.

In claim 17:

The term -- of laser power-- should be inserted after “average”, lines 8 and 8; otherwise, it is unclear from the claim of what average the laser device has.

In claim 19:

The term -- of laser power-- should be inserted after “average”, lines 8 and 8; otherwise, it is unclear from the claim of what average the laser device has.

Claims 2, 5, 7, 8, 15, 16, 18, and 20 fall with their respective parent claim.

4. Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 16 is directed to an optical information recording medium while claim 14 directed an initializing apparatus. Accordingly, the optical information recording medium recited in claim 16 does not the subject matter recited in apparatus claim 14.

Note: Claim 16 is an improper dependent claim since an optical information recording medium recited in claim 16 is not a product of apparatus claim 14.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kasami et al (US 6,373,814).

Kasmi et al., according to Figs. 1-6 discloses a phase change optical information recording medium having guide tracks as recited in claims 16-20.

Note: limitation/feature “initializing by the apparatus according to claim 14” recited in claim 16, or limitations/features “initialized by a semiconductor laser device ... the semiconductor laser is polished” recited in claim 16 or 19, lines 1-13, or all limitations in claim 18 or 20, are not directed to structures of the medium as claimed, but are directed an initializing apparatus and its the functional operation intended to be used with the medium. Accordingly, all limitations/features directed to the apparatus and its functional operation are not given any patentable weight since these limitations/features are not the structure(s) of the medium.

***Claims Allowable Over Prior Art Of Record***

7. Claims 1-8, 14 and 15 would be allowable over the prior art of record if rewritten or amended to overcome the objection(s) to under 37 CFR 1.75(a), set forth in this Office action.

8. Claims 1-15 are allowable over the prior art of record as to the prior art of record, considered in combination or individually, fails to suggest or fairly teach a method or apparatus

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for initializing a phase-change optical information recording medium including a combination of all limitations recited in each of claims 1, 9 and 14. Claims 2-8, 10-13 and 15 are allowable over the prior art of record with their respective parent claim.

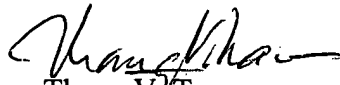
*Cited references*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references relate a phase change recording medium having guide tracks initialized by an optical apparatus.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thang V. Tran whose telephone number is (571) 272-7595. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Thang V. Tran  
Primary Examiner  
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